

Appl. No. 10/726,601
Amendment dated: February 11, 2005
Reply to OA of: August 11, 2004

REMARKS

Applicant has amended the claims formally, and added three new claims to more particularly define the invention taking into consideration the outstanding Official Action and as fully supported by the application as originally filed. Applicant most respectfully submits that all the claims now present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

Rejections under 35 USC 102

The rejection of claims 1-3, 5 and 6 under 35 U.S.C. §102(b) as being anticipated by Lee and claims 9-11 and 13-16 as being anticipated by Cross has been carefully considered but is most respectfully traversed.

Applicant wishes to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

The cited reference 4,991,468 to Lee discloses that the caps 30 and 60 are coaxially elastically connected with the detent rings 50 and 70, respectively. As can be seen in Fig. 2 of Lee, the detent rings are situated in assembly between an outer surface of the drive wheel 17 and a corresponding outer surface of a respective cap

Appl. No. 10/726,601
Amendment dated: February 11, 2005
Reply to OA of: August 11, 2004

(30,60). No such arrangement exists or is contemplated by the present invention. As defined in claim 1 of the present invention, no such detent rings are claimed. Instead, the annular members are ***firmly fastened to the engagement portions of the said ratchet wheel.*** The engagement portions of said ratchet wheel are the portions identified in the specification by the reference numeral 33. Clearly, the engagement claimed and that disclosed by Lee are quite different, and the difference is a structural difference which takes claim 1, and those claims which depend therefrom out of the application sphere of 35 USC 102 relative to Lee 4,991,468.

Claim 9 is in independent form. Like claim 1, claim 9 also defines an engagement mode which is different from that of Lee and Cross. Claim 9 defines the engagement whereby ***said annular member is firmly fastened to said engagement portion of said ratchet wheel.*** This engagement distinguishes over Lee for the reasons noted above.

Regarding Cross, it discloses a wrench according to which a locking ring 28 is fastened by a screw 29 to the jaw 21. The surface engagements in Cross are irrelevant to the design as far as "fit" is concerned.

Cross, like Lee, does not teach or suggest the surface engagement of the present invention noted above so that it, like Lee, cannot invoke 35 USc 102.

The rejections under 35 USC 103

The rejection of claims 4 and 12 under 35 U.S.C. 103 as unpatentable over Lee and Cross respectively and claims 7 and 8 over Lee in view of Cross has been carefully considered but is most respectfully traversed.

Applicants wish to direct the Examiner's attention to the basic requirements of a *prima facie* case of obviousness as set forth in the MPEP § 2143. This section states that to establish a *prima facie* case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves

Appl. No. 10/726,601
Amendment dated: February 11, 2005
Reply to OA of: August 11, 2004

or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence present by applicant and the citation of *In re Soni* for error in not considering evidence presented in the specification. Accordingly, it is most respectfully requested that these rejections be withdrawn.

New Claims

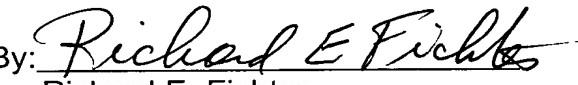
New claims 17-19 have been added to complete the defined scope of the invention. Claim 17 further defines the engagement surfaces, claim 18 defines the embossment at the engagement surfaces, and claim 19 defines the threads at the engagement surface. Like claims 1 and 9, claim 17, and claims 18 and 19 which depends therefrom, define patentably over the references of record.

Appl. No. 10/726,601
Amendment dated: February 11, 2005
Reply to OA of: August 11, 2004

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

BACON & THOMAS, PLLC

By: 
Richard E. Fichter
Registration No. 26,382

625 Slaters Lane, 4th Fl.
Alexandria, Virginia 22314
Phone: (703) 683-0500
Facsimile: (703) 683-1080

REF:FJD:kdd
A01.wpd

February 11, 2005